



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/647,946	12/06/2000	Robert C. Brunham	1038-1094MIS	7359
24223	7590	05/23/2005	EXAMINER	
SIM & MCBURNEY 330 UNIVERSITY AVENUE 6TH FLOOR TORONTO, ON M5G 1R7 CANADA			SWARTZ, RODNEY P	
			ART UNIT	PAPER NUMBER
			1645	
DATE MAILED: 05/23/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/647,946

Applicant(s)

BRUNHAM, ROBERT C.

Examiner

Rodney P. Swartz, Ph.D.

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10February2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-33 and 36-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-33,36-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's Response to Office Action, received 10 February 2005, is acknowledged. Claims 1-15, 34, and 35 have been cancelled. Claims 16, 24, and 25 have been amended. New claims 36-42 have been added.
2. Claims 16-33 and 36-42 are pending and under consideration.

Rejections Moot/Withdrawn

3. The rejection of claims 1-15, 34, and 35 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Pat. No. 6,235,290, is moot in light of the cancellation of the claims.
4. The rejection of claims 1-15, and 34 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Pat. No. 6,344,202, is moot in light of the cancellation of the claims.
5. The rejection of claims 1-15, 34, and 35 under 35 U.S.C. 103(a) as being unpatentable over Baxby et al (*Vaccine*, 10(1):8-9, 1992) in view of Dascher et al (*Microbial Pathogenesis*, 15:455-467, 1993) or Douglas et al (*J. Bacteriol.*, 178(19):5573-5578) or Kaul et al (*Gene*, 87(1):97-104, 1990) and further in view of Anderson et al (*Inf. Immun.*, 64(8):3168-3173, 1996) and applicant's admission of record, is moot in light of the cancellation of the claims.
6. The rejection of claims 16-33 under 35 U.S.C. 103(a) as being unpatentable over Baxby et al (*Vaccine*, 10(1):8-9, 1992) in view of Dascher et al (*Microbial Pathogenesis*, 15:455-467, 1993) or Douglas et al (*J. Bacteriol.*, 178(19):5573-5578) or Kaul et al (*Gene*, 87(1):97-104, 1990) and further in view of Anderson et al (*Inf. Immun.*, 64(8):3168-3173, 1996) and applicant's admission of record, is withdrawn in light of applicant's arguments.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 16-33 and 36-42 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13, 16-23, 25-27, 33-37, 39, and 40 of copending Application No. 10/964,670. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claim 16 of the instant application is drawn to a method of immunizing a host comprising administration of a nonreplicating vector comprising a nucleotide sequence encoding a region consisting of ≥ 1 of the conserved domains 2, 3, and 5 of a major outer membrane protein (MOMP) of a strain of *Chlamydia* and a promoter sequence operatively coupled to said nucleotide sequence for expression of said ≥ 1 conserved domain in the host. Claims 17-33 and 36-42 add further criticalities to the method of claim 16.

Claim 13 of copending application no. 10/964,670 is drawn to a method of immunizing a host comprising administration of a nonreplicating vector comprising a nucleotide sequence encoding a MOMP fragment of a major outer membrane protein (MOMP) of a strain of *Chlamydia* and a promoter sequence operatively coupled to said nucleotide sequence for expression of said MOMP fragment in the host. Claims 16-23, 25-27, 33-37, 39, and 40 add

Art Unit: 1645

further criticalities to the method of claim 13 which correspond to claims 17-33 and 36-42 of the instant specification.

Thus, claim 13 of copending application no. 10/964,670 utilizes vectors comprising nucleotides of any fragment of MOMP. This encompasses fragments such as those consisting of conserved domains 2, 3, or 5.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

9. No claims are allowed.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney P. Swartz, Ph.D., Art Unit 1645, whose telephone number is (571) 272-0865. The examiner can normally be reached on Monday through Thursday from 5:30 AM to 4:00 PM EST.

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Lynette F. Smith, can be reached on (571)272-0864.

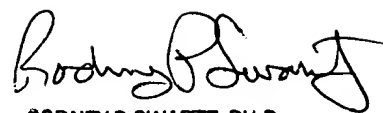
The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 09/647,946

Page 5

Art Unit: 1645

A handwritten signature in black ink, appearing to read "Rodney P. Swartz". The signature is fluid and cursive, with a large initial 'R' and 'S'.

RODNEY P SWARTZ, PH.D
PRIMARY EXAMINER
Art Unit 1645

May 18, 2005